

### **REMARKS/ARGUMENTS**

Applicants respond herein to the Office Action of February 5, 2007.

The Office Action has been carefully considered. Claims 1-5, 7-17 and 19-32 were pending in the Office Action with claims 1, 29 and 32 being in independent form. By the present Amendment, claims 1, 5 and 9 have been amended to further clarify the features of the present application and claim 29-32 have been canceled without prejudice or disclaimer.

The Examiner has objected the drawings as allegedly failing to show every feature of the invention specified in the claims. In particular, the Examiner argues that the support, the base member, the elongate member and the extended portion of claim 1 must be shown in the Figures. Applicants respectfully disagree.

Fig. 4 clearly illustrates the rotary cover (support) 85 which supports the jaws 101, 102 of the treatment section or end effector 3 of the present application. Indeed, in paragraph 0072 of the present application, the rotary cover 85 is specifically referred to as a support. Further, it is clear that the support 85 is supported by the base 81 as is also described in paragraph 0072. In addition, the sheath 5 which is specifically referred to as a type of an elongate member in paragraph 0042 of the present application is illustrated in several figures including Fig. 13, for example. Also, in Fig. 13, the extended portion 115a of the sheath 5 is clearly illustrated. Thus it is respectfully submitted that the support, the base, the elongate member and the extended portion of claim 1 are all clearly illustrated in the drawings of the present application.

Accordingly, it is respectfully submitted that the objection to the drawings be reconsidered and withdrawn.

The Examiner has objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner argues that claim 30 refers to a “rotation mechanism” and that this term is not used in the specification.

By the present Amendment, the paragraph beginning on page 25, line 5 has been amended to include the term “rotation mechanism.” Support for this amendment can be found at least in original claim 30 of the present application.

Accordingly, it is respectfully requested that the objection to the specification be reconsidered and withdrawn.

Claims 1, 4 and 5 have been rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. Reconsideration of this rejection is respectfully requested.

The Examiner notes that claim 4 states that the elongate member is a sheath, while claim 1 states that the elongate member has a base member on the distal end. The Examiner contends that it is not clear how the base member is located on the distal end of the elongate member. By the present Amendment, claim 1 has been amended to clarify the features of the present application. Specifically, claim 1 has been amended to specify that the base member is located “at” the distal end of the elongate member. It is believed that amended claim 1 clarifies the relation between the elongate member and the base member and is fully supported by the specification and drawings of the present application.

With regard to claim 5, the Examiner argues that the statement in claim 5 that the extended portion has a “slope” is not clear from the drawings or described in the specification. Claim 5 has been amended herein in order to clarify the features of the present application. In particular, claim 5 has been amended to specify that “the extended portion has an annular distal end surface inclined relative to a central axis of the sheath.” This is clearly illustrated in Fig. 13, for example, of the present application.

Accordingly, it is respectfully requested that the rejection of claims 1, 4 and 5 under 35 U.S.C. §112, first paragraph, be reconsidered and withdrawn.

Claim 9 has been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Reconsideration of this rejection is respectfully requested.

The Examiner contends that claim 9 is unclear since he does not understand what Applicants intend to claim in lines 3-4 thereof. Specifically, the Examiner does not understand how the extended portion has a tube that is cut out from the sheath. By the present Amendment claim 9 has been amended to further clarify the features of the present application. It is believed that amended claim 9 particularly points out and distinctly claims the subject matter which applicants regard as the invention.

Accordingly, it is respectfully requested the rejection of claim 9 under 35 U.S.C. §112, second paragraph, be reconsidered and withdrawn.

Claims 29-32 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 6,394,998 to Wallace et al. (hereinafter “Wallace”). As is noted above, claims 29-32 have been canceled herein without prejudice or disclaimer, however, Applicants reserve the right to pursue these claims in a future divisional or continuation application.

Accordingly, it is respectfully submitted that the rejection of claims 29-32 is moot in light of the cancellation of these claims herein.

Claims 1-5, 7-17, and 19-28 have been rejected under 35 U.S.C. §103(a) as allegedly being unpatentable U.S. Patent No. 5,554,844 to Lee et al. (hereinafter “Lee”) in view of U.S. Patent No. 6,066,151 to Miyawaki et al (hereinafter “Miyawaki”). Reconsideration of this rejection is respectfully requested.

The Examiner contends that Lee substantially discloses all of the features of claim 1, for example, of the present application. The Examiner concedes, however, that Lee does not disclose an elongate member. The Examiner argues that Miyawaki discloses this feature and that it would have been obvious to modify Lee to include the sheath taught by Miyawaki. Applicants respectfully disagree.

Lee discloses a surgical instrument including an end effector 18. The end effector 18 is comprised of four members including the base 600, link 601, upper grip of jaw 602 and lower grip or jaw 603. The base 600 is affixed to a flexible stem section 303.

Lee, however, fails to disclose a surgical instrument including “an extended portion which is disposed in the distal end of the elongate member to prevent one of forward rotation and backward rotation of the base member with respect to the support, and also to extend and cover at least one side of the base member,” as is required by amended claim 1 of the present invention. The Examiner argues that reference numerals 300, 302 and 303 in Lee correspond to “an extended portion”. This is clearly incorrect.

Element 300 of Lee is a coupler. Elements 302 and 303 relate to an elongated rigid section 302 and an elongated flexible section 303. While the end effector 18 is connected to the flexible section 303, none of the elements 300, 302 or 303 “prevent one of forward rotation and backward rotation of the base member with respect to the support” as is required by amended claim 1 of the present application. Indeed, there is no mention at all in Lee of preventing rotation.

Further, there is no disclosure in Lee that any of the coupler 300, the elongate rigid section 302 and the elongate flexible section 303 “extend and cover at least one side of the base member,” as is also required by amended claim 1 of the present application. Indeed, as can be seen in Fig. 4, none of these elements extends beyond the base of the end effector 18.

In addition, Miyawaki also fails to disclose this feature. As noted above, the examiner concedes that Lee does not disclose an elongate member but refers to Miyawaki as allegedly disclosing this feature. The Examiner indicates that the sheath 31 in Miyawaki as an “elongate member.” The Examiner also argues that the sheath 31 is integral with a so-called extended portion 71 and is extendable with respect to the base member, which allegedly corresponds to element 100 in Miyawaki. However, this is clearly not the case. Element 71 of Miyawaki is a vibration transmitting member. The vibration transmitting member 71 in Miyawaki is disposed in a central portion of the sheath 31 as can be seen with reference to Figs. 2A, 2B of Miyawaki. Thus, there is no disclosure in Miyawaki of an extended portion, “disposed in the distal end of the elongate member,” as is required by amended claim 1 of the present application. Further, the element 71 of Miyawaki is not integral with the sheath 31 as can also be seen with reference to Figs. 2A, 2B of Miyawaki.

Further, even if the element 71 could be considered an extended portion, there is no disclosure in Miyawaki that it prevents “one of forward rotation and backward rotation of the base member with respect to the support, “ or that it extends and covers “at least one side of the base member,” as is required by amended claim 1 of the present application.

Thus, none of the references cited by the Examiner show or suggest a surgical instrument including “an extended portion which is disposed in the distal end of the elongate member to prevent one of forward rotation and backward rotation of the base member with respect to the support, and also to extend and cover at least one side of the base member,” as is required by amended claim 1 of the present invention.

Accordingly, it is respectfully submitted that amended claim 1, and the claims depending therefrom, are patentable over the cited art for at least the reasons described above.

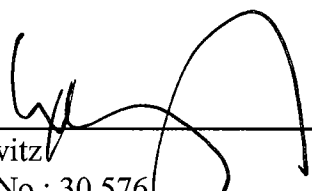
The remaining claims all depend from independent claim 1, either directly or indirectly, and thus, are believe to be patentable over the cited art for at least similar reasons as those described above.

In light of the remarks and amendments made herein, it is respectfully submitted that claims 1-5, 7-17 and 19-32 are patentable over the cited art and are in condition for allowance.

Favorable reconsideration is respectfully requested.

Respectfully submitted,

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THROUGH THE UNITED STATES  
PATENT AND TRADEMARK OFFICE  
EFS FILING SYSTEM  
ON AUGUST 3, 2007



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